

REMARKS/ARGUMENTS

**Claims Status / Support for Amendments**

Claims 6, 10-13 and 15-17 are pending. Claims 1-5, 7-9 and 14 are currently canceled without prejudice. Claims 6, 10-13 and 15-17 are amended. Independent claim 6 is amended to include the subject matter of dependent claims 7-9 and 14. Dependent claims 10-13 and 15-17 are amended for antecedent basis purposes and claim dependency purposes in light of the amendment to independent claim 6. No new matter has been entered.

**§103(a) Rejections**

Claims 6-17 are rejected under 35 U.S.C. §103(a) as obvious Manson (US 2,413,239) in view of Synosky (US H1241) and further in view of either Trotoir (US 5,053,444) or Young (US 2,595,911). Claims 6-17 are also rejected under 35 U.S.C. §103(a) as obvious over Synosky. Applicants respectfully traverse these rejections.

With respect to the allegations of obviousness over Synosky alone, Applicants note that the Office has not specifically addressed any of dependent claims 8-17, three of which are now currently present in the independent claim. Instead, the Office merely states “It is further maintained that the incremental mixing techniques and particular mixing parameters of claims 8-17 are obvious design choices.” Applicants submit that this very generalized statement of “obvious design choices” by the Office is in fact rebutted by the very reference that the Office has cited, namely Synosky.

Column 5, lines 10-13 of Synosky states “Elastomers provide the rubbery, cohesive nature to the gum which varies depending on the elastomer’s chemical and physical properties, and *how the elastomer is blended with other ingredients.*” (italics emphasis added). It should be noted here that after this statement, Synosky is silent with respect to the claimed processing parameters.

Accordingly, given that (i) the pending claims are drawn toward a *process* of producing a wax composition, (ii) Synosky itself discloses that the processing/mixing techniques can affect the nature of the resulting gum, and (iii) Synosky is silent on the claimed processing/mixing parameters, Applicants submit that the Office has failed to establish a *prima facie* case of obviousness over the claimed invention.

Applicants further submit that the statement by the Office that “the incremental mixing techniques and particular mixing parameters of claims 8-17 are obvious design choices” is nothing more than a “mere statement that the claimed invention is within the capabilities of one of ordinary skill in the art.” As MPEP 2143.01 (Part IV) explains, a “mere statement that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness” (underline emphasis added).

Accordingly and in view of the Office’s failure to establish a *prima facie* case of obviousness over the claimed invention in light of Synosky alone, Applicants request withdrawal of the obviousness rejection over Synosky.

Regarding the obviousness rejection over Manson in view of Synosky and further in view of either Trotoir or Young, Applicants provide the following remarks *in addition to* those already presented above with respect to Synosky.

Just like noted above with respect to Synosky alone, the Office has not specifically addressed any of dependent claims 8-17, three of which are now currently present in the independent claim, when discussing any of Manson, Synosky, Trotoir and/or Young. Instead, the Office again merely states “It is further maintained that the incremental mixing techniques and particular mixing parameters of claims 8-17 are obvious design choices.”

The claimed invention as put forth in independent claim 6 recites a batchwise (i.e., first and second kneading substeps) and incremental (i.e., adding the microcrystalline wax in

divided portions in each of the first and second kneading substeps) production of a wax/polymer composition. None of the cited references, alone or in combination, disclose or suggest a batchwise and incremental production of a wax/polymer composition.

As noted above, Synosky is silent on the claimed processing/mixing parameters. Accordingly, Synosky is also necessarily silent on the batchwise and/or incremental nature of the claimed production process. The Office has alleged that Manson, Trotoir and Young all disclose masterbatch mixing techniques (see page 4 of Office Action dated March 18, 2010). However, what the Office has failed to point out or establish is a disclosure/suggestion by any one or more of the cited references of an **incremental addition of the wax component within each batch step** during the wax/polymer composition production as claimed. Furthermore, Applicants note that the Office has also failed to establish motivation for one skilled in the art to further divide that which is already divided into batchwise steps.

Thus, since none of Manson, Synosky, Trotoir or Young, alone or in combination, disclose or suggest the claimed batchwise and incremental (within each batch step) production of a wax/polymer composition, Applicants submit that the Office has failed to establish a *prima facie* case of obviousness over the claimed invention.

Again, Applicants remind the Office that the mere statement that “the incremental mixing techniques and particular mixing parameters of claims 8-17 are obvious design choices” is nothing more than a “mere statement that the claimed invention is within the capabilities of one of ordinary skill in the art,” and as MPEP 2143.01 (Part IV) explains, a “mere statement that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness.”

With respect to dependent claims 10 and 15 specifically, Applicants point out that these claims recite particular wt% amounts for the incremental addition of the wax component within the first batch step (i.e., claim 10, 1 to 15 wt%) and within the second

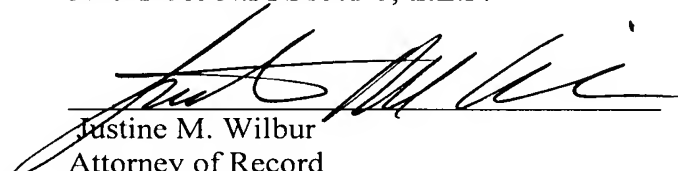
batch step (i.e., claim 15, 5 to 30 wt%). Applicants also point out that all of the cited references are silent with respect to these particularly claimed incremental addition ranges *within each batch step*. Accordingly, Applicants submit that no combination of the cited references renders obvious dependent claims 10 and 15.

### **Conclusion**

Accordingly, Applicants submit that all now-pending claims are in condition for allowance. Applicants respectfully request withdrawal of the rejections and passage of this case to issue.

Respectfully submitted,

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